



REMARKS

This Response is filed in connection with the final Office Action mailed August 31, 2005. In the Office Action, the Examiner stated that the Amendment and Response Under 37 C.F.R. § 1.111, filed on February 2, 2005, has been entered. Applicants make no amendments to the presently pending claims at this time. Thus, claims 13-16, 26 and 27 are currently pending in the application. No new matter has been introduced.

I. THE REJECTION UNDER 35 U.S.C. § 112, FIRST PARAGRAPH, FOR LACK OF WRITTEN DESCRIPTION, SHOULD BE WITHDRAWN

The Examiner has rejected claims 13, 15-16 and 26-27 for lack of written description under 35 U.S.C. § 112, 1st ¶, for the alleged failure of the disclosure to provide an adequate written description, the reasons for which are set forth in the current and previous Office Actions.¹ Applicants respectfully submit that the rejection is erroneous because (1) the Examiner appears to have consistently mischaracterized the nature of the invention; (2) the Examiner has misapplied the legal standard for written description under § 112, 1st ¶; and (3) the claimed invention is adequately described.

A. The Invention is Mischaracterized

The Examiner contends that there is a lack of written description for "a method for genus of nucleic acid [sic] whose function is not known."² Further, the Examiner states that the "essential feature of the claimed method is the discovery that nucleic acid sequences which have not been identified by function such as SEQ ID NO:1 can be used as regulated sequence of the estrogen modulation but the function of SEQ ID NO:1 is not known."³ Applicants respectfully submit that this is a mischaracterization of the present invention. The "discovery" is *not* the "method for genus nucleic acids whose function is not known," as the Examiner contends. Rather, the presently claimed invention is directed to the

¹ See, August 31, 2005 Office Action at pp. 2-3; November 2, 2005 Office Action at pp. 2-3; March 25, 2003 Office Action at pp. 2-3; and October 21, 2003 Office Action at pp. 2-3.

² August 31, 2005 Office Action at p. 3.

³ *Id.* In support of this argument, the Examiner cites to the nucleic acid sequence identified by NCI-CGAP accession number AA747315 (1999) (corresponding to SEQ ID NO:1) and alleges that this sequence resulted from a human genome sequencing and that "the function of the sequence is not known." *Id.*

2/20/07 RDP
NO claim amendments
OK to enter - Response